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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO.    |
|---|-------------|----------------------|-----------------------|---------------------|
| 09/941,519  | 08/29/2001  | William R. Wheeler   | 10559-605001 / P12889 | 6850                |
| 20985   | 7590        | 06/29/2004           | EXAMINER              |                     |
| FISH & RICHARDSON, PC<br>12390 EL CAMINO REAL<br>SAN DIEGO, CA 92130-2081 |             |                      |                       | THOMPSON, ANNETTE M |
| ART UNIT  |             | PAPER NUMBER         |                       |                     |
|   |             | 2825                 |                       |                     |

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                                 |
|------------------------------|-----------------|---------------------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s) <i>(Signature)</i> |
|                              | 09/941,519      | WHEELER ET AL.                  |
|                              | Examiner        | Art Unit                        |
|                              | A. M. Thompson  | 2825                            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 March 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-18 and 20-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-18 and 20-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 September 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/22/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicants' submission filed on 22 March 2004 has been entered.

2. Claims 1, 3-18 and 20-38 are pending.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Rejection of claims 1, 3-18, 20-38**

4. Claims 1, 3-18 and 20-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawman et al. (Lawman), U.S. Patent 5,673,198. Lawman discloses a concurrent electronic circuit design and implementation.

5. Pursuant to claim 1, Lawman discloses a method of designing a semiconductor device (see Abstract), the method comprising maintaining a circuit design parameter file (col. 8, line 34 to col. 9, line 14) for a circuit being designed (col. 2, ll. 19-29), the circuit

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design parameter file specifying a physical characteristic of the circuit (col. 2, ll. 19-39); monitoring a design environment to detect an addition of a circuitry component to the circuit (col. 2, ll. 41-56; see also col. 6, ll. 5-55); accessing a component design parameter file that specified at least one design parameter for that added circuitry component (col. 2, ll. 19-39); updating the circuit design parameter file based on the at least one design parameter included in the component design parameter file (col. 6, ll. 5-25); and providing a circuit designer with feedback concerning the physical characteristic of the circuit being designed (col. 6, ll. 5-25).

6. Pursuant to claim 3, further comprising allowing the circuit designer to request feedback concerning the physical characteristic of the circuit being designed (col. 6, ll. 50-55).

7. Pursuant to claims 4-14 wherein the designer is provided/updated with feedback concerning physical characteristics of the circuit being designed (col. 2, ll. 35-40; col. 2, ll. 49-56; col. 3, ll. 5-21; col. 3, ll. 24-32; col. 3, ll. 58-65; col. 9, ll. 15-29).

8. Pursuant to claim 15 further comprising monitoring a design environment to detect the deletion of a circuitry component (col. 9, ll. 38-52).

9. Pursuant to claim 16, further comprising accessing a component design parameter file that specifies at least one design parameter for the deleted component (col. 9, ll. 30-52).

10. Pursuant to claim 17, comprising updating the circuit design parameter file. . . (col. 9, ll. 30-52).

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11. Pursuant to claim 18, Lawman discloses an estimation process for designing a semiconductor device comprising a parameter file maintenance process for maintaining a circuit design parameter file for a circuit being designed (col. 8, line 34 to col. 9, line 14), the circuit design parameter file specifying a physical characteristic of said circuit (col. 2, ll. 19-39); a design space monitoring process for monitoring a design environment to detect the addition of a circuitry component to said circuit (col. 2, ll. 41-56; see also col. 6, ll. 5-55); a component file access process for accessing a component design parameter file that specified at least one design parameter for said added circuitry component (col. 2, ll. 19-39); a parameter file updating process for updating said circuit design parameter file based on said at least one design parameter included in said component design parameter file (col. 6, ll. 5-25); and a feedback display process for providing a circuit designer with feedback concerning said physical characteristic of said circuit being designed (col. 6, ll. 5-25).

12. Pursuant to claim 20, further comprising allowing the circuit designer to request feedback concerning the physical characteristic of the circuit being designed (col. 6, ll. 50-55).

13. Pursuant to claims 21-31, wherein the designer is provided/updated with feedback concerning physical characteristics of the circuit being designed (col. 2, ll. 35-40; col. 2, ll. 49-56; col. 3, ll. 5-21; col. 3, ll. 24-32; col. 3, ll. 58-65; col. 9, ll. 15-29).

14. Pursuant to claim 32 further comprising monitoring a design environment to detect the deletion of a circuitry component (col. 9, ll. 38-52).

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15. Pursuant to claim 33, further comprising accessing a component design parameter file that specifies at least one design parameter for the deleted component (col. 9, ll. 30-52).

16. Pursuant to claim 34, comprising updating the circuit design parameter file. . . (col. 9, ll. 30-52).

17. Pursuant to claim 35, this independent claim incorporates the limitations already rejected in independent claims 1 and 18. Lawman discloses the additional limitation of a computer program product residing on a computer readable medium having a plurality of instructions stored thereon which when executed by a processor cause that processor to perform the method (col. 5, ll. 8-26).

18. Pursuant to claim 36, wherein said computer readable medium is a hard disk drive (Fig. 1; col. 5, ll. 8-25).

19. Pursuant to claim 37, this independent claim incorporates the limitations already rejected in independent claims 1 and 18. Lawman discloses the additional limitation of a processor and memory configured to perform the method (col. 5, ll. 8-26).

20. Pursuant to claim 38, wherein said processor and memory are incorporated into a personal computer (col. 1, ll. 12-20; Fig. 1; col. 5, ll. 8-20).

### ***Conclusion***

21. Applicants' submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 22 March 2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS**

**MADE FINAL.** See MPEP § 609(B)(2)(i). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications should be directed to Examiner A.M. Thompson whose telephone number is (571) 272-1909. The Examiner can usually be reached Monday thru Friday from 8:00 a.m. to 4:30 p.m.. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Matthew S. Smith, can be reached on (571) 272-1907.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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23. Responses to this action should be mailed to the appropriate mail stop:

Mail Stop \_\_\_\_\_

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306, (for all OFFICIAL communications intended for entry)



A. M. THOMPSON  
Primary Examiner  
Technology Center 2800